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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,285	06/24/2003	Michael E. Shanahan	116236-00010	4408
27614	7590	12/23/2008	EXAMINER	
MCCARTER & ENGLISH, LLP FOUR GATEWAY CENTER 100 MULBERRY STREET NEWARK, NJ 07102				NGUYEN, TUAN HOANG
ART UNIT		PAPER NUMBER		
2618				
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12/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/603,285	SHANAHAN, MICHAEL E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TUAN H. NGUYEN	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 August 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 57-102 is/are pending in the application.

4a) Of the above claim(s) 1-56 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 57-83,89,90,96 and 102 is/are rejected.

7) Claim(s) 84-88,91-95 and 97-101 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed on 08/29/2008 with respect to claims 57-102 have been considered but are moot in view of the new ground(s) of rejection.
2. Claims 1-56 cancelled.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 57, 66, and 75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 57, 66, 75, the limitations “...allow the user of the wireless telephone to optionally **download a selected video file into the wireless telephone for future use as an indicia of the incoming communication...**” are not described in the specification.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

6. Claims 57, 62-65, 66, 71-74, 75, 80-83, and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky").

Consider claim 57, 66, and 75, Galensky teaches for providing a video file to a wireless telephone for use as an indicia of an incoming communication, the system comprising: a remote computer with access to a database of video files suitable for downloading to the wireless telephone (col. 7 lines 25-42) wherein the remote computer is configured to: provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files (col. 1 lines 20-31); allow the user of the wireless telephone to browse the list of video files (col. 4 line 66 through col. 5 line 9); allow the user of the wireless telephone to select a desired video file from the list of video files (col. 5 lines 31-36); and allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for future use as an indicia of the incoming communication (col. 4 lines 42-48); and confirming the selected video file has been properly received by the wireless telephone (col. 2 lines 14-28).

Consider claims 62, 71, and 80, Galensky further teaches the remote computer is further configured to provide a plurality of lists of video files for browsing by the user of the wireless telephone (col. 4 line 66 through col. 5 line 9).

Consider claims 63, 72, and 81, Galensky further teaches the database is configured to include video files in a format selected from the group comprising MPEG, JPEG, AVI, or DVD format (col. 1 lines 19-27).

Consider claims 64, 73, and 82, Galensky further teaches configured to provide copyright protection for the database of video files to help prevent unauthorized distribution of video files downloaded by the user of the wireless telephone (col. 6 lines 45-58).

Consider claims 65, 74, and 83, Galensky further teaches configured to coordinate downloading of the selected video file such that the user of the wireless telephone is informed when the wireless telephone has insufficient available memory capacity to successfully download the selected video file.

Consider claims 90, Galensky further teaches the remote computer is further configured to confirm the selected video file has been properly received by the wireless telephone (col. 2 lines 14-28).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 58-61, 67-70, and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky in view of Isomursu et al. (US PAT. 7,088,990 hereinafter, "Isomursu").

Consider claims 58, 67, and 77, Galensky teaches for providing a video file to a wireless telephone, the system comprising: a remote computer with access to a database of video files suitable for downloading to the wireless telephone wherein the remote computer is configured to: provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files; allow the user of the wireless telephone to browse the list of video files; allow the user of the wireless telephone to select a desired video file from the list of video files; and allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for use as desired by the user of the wireless telephone.

Galensky does not explicitly show that the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information.

In the same field of endeavor, Isomursu teaches the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information (col. 8 lines 16-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information, as taught by Isomursu, in order to provide the terminal capable of supporting a plurality of applications and having communicating user messages wherein it comprises receiving user messages having data and a header relating to one of applications and addressing the data to a respective application according to header.

Consider claims 59, 68, and 78, Isomursu further teaches configured to allow the user of the wireless telephone to review the selected video file before downloading the selected video file into a programmable memory in the wireless telephone (col. 14 line 47 through col. 15 line 6).

Consider claims 60, 69, and 79, Isomursu further teaches configured to provide the user of the wireless telephone with the option of downloading the selected video file into a programmable memory in the wireless telephone after reviewing the selected video file (col. 14 line 47 through col. 15 line 6).

Consider claims 61 and 70, Isomursu further teaches configured to provide the user of the wireless telephone with the option of editing the selected video file before programming the selected video file into the programmable memory in the wireless telephone (col. 10 lines 32-57).

Consider claim 76, Isomursu further teaches configured to operate in conjunction with a distribution computer to confirm the selected video file/polyphonic audio file has been properly received by the wireless telephone (col. 14 line 47 through col. 15 line 6).

9. Claims 89, 96, and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky in view of well known prior art.

Consider claims 89, 96, and 102, Galensky teaches the method and system of claims 57, 66, and 75 as described above. Galensky, however fails to teach the Internet that operates in compliance with a Wireless Application Protocol (WAP).

The examiner contends, however, that the WAP is a well-known protocol used in the communications environment.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Galensky with the teachings of well-known prior art since it is known that WAP is a protocol used by devices to connect to the Internet.

***Allowable Subject Matter***

10. Claims 84-88, 91-95, and 97-101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any response to this action should be mailed to:

Mail Stop \_\_\_\_\_ (Explanation, e.g., Amendment o  
After-final, etc.)

Commissioner for Patents

P.O. Box 1450  
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Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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